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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,247	02/06/2004	Luc Jutras	87367.2200	6878

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EXAMINER
LAUX, JESSICA L

ART UNIT 3635	PAPER NUMBER
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DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/772,247		JUTRAS, LUC	
	Examiner		Art Unit	
	Jessica Laux		3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-13 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/17/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the peel-off membrane used with the adhesive must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10, 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the step of peeling off a peel-off membrane from the adhesive, as in claim 13, can occur before the adhesive is applied to the curb. Further it is unclear the type of adhesive being used and how it is being used. (i.e. is it an adhesive applied during the installation process whereby the grooves are necessary to help in adhering (such as for a liquid adhesive), or is it a preinstalled adhesive (such as a double sided adhesive tape) with a peel-off membrane that is peeled off during installation.) Clarification is necessary.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Georgeau et al. (5493827).

Regarding claim 1: Georgeau discloses a pitch pocket for sealing a physical penetration of a roof, said pitch pocket comprising: a curb (12) having an inner (30) peripheral surface and an outer peripheral surface (Figure 6), the inner peripheral surface defining an opening (32) for said physical penetration to pass through, said curb

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further defining a base surface (26); an adhesive (24) applied to at least a portion of the base surface (Col. 2, lines 57-59) and adapted to secure the pitch pocket to the roof; and a sealant (14) cast within the opening of said curb and forming a solid seal around the physical penetration (Col. 1, lines 61-63); characterized in that the curb is formed out of a single semi-rigid unit (Col. 4, lines 18-19) and is provided with a split (Figure 1 at elements 20 and 22) for allowing the installation of the curb around the physical penetration.

Regarding claim 2: A pitch pocket according to claim 1 wherein said curb has an annular shape (Col. 3, line 6, where it is ring shaped).

Regarding claim 3: A pitch pocket according to claim 1 wherein said split is a straight through cut (Figure 1).

Regarding claim 4: A pitch pocket according to claim 3 wherein the straight through cut lies in a plane different from a radial plane (Col. 2, lines 50-51).

Regarding claim 5: A pitch pocket according to claim 1 wherein said outer peripheral surface and said inner peripheral surface of the curb are joined by an upper edge (34) located in a top portion of the opening; and said outer peripheral surface of the curb and said base surface are joined by a lower edge; the outer peripheral surface (38) being slanted from the upper edge at the top of the opening towards the lower edge in order to evacuate any liquid away from the solid seal around the physical penetration (Figures 2 and 6).

Regarding claim 12: Georgeau discloses a method for sealing a physical penetration of a roof using a pitch pocket comprising a curb (12) with an opening and a

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split (at 20 and 22), the opening being filled with sealant (14), the method comprising the steps of: spreading two opposed ends of said curb formed by said split, thus opening the curb; placing said opened curb around the penetration; closing said curb by applying an adhesive to join said two opposed ends together; securing said curb to the roof by applying adhesive to at least one portion of a base surface of the curb (Col. 4, lines 10-23); preparing said sealant; casting within the opening of said curb said sealant for forming a solid seal around the physical penetration (Col. 4, lines 23-29); allowing the sealant to cure and to seal the physical penetration.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodman et al. (4928443)

Regarding claim 1: Goodman discloses a pitch pocket for sealing a physical penetration of a roof, said pitch pocket comprising: a curb (12 and 13) having an inner peripheral surface (17) and an outer peripheral surface (14), the inner peripheral surface defining an opening (Figure 1)) for said physical penetration to pass through, said curb further defining a base surface (37); an adhesive applied to at least a portion of the base surface (where flange 37 is formed from member 22 which has an adhesive backed surface) and adapted to secure the pitch pocket to the roof; and a sealant (39) cast within the opening of said curb and forming a solid seal around the physical penetration (Figure 1); characterized in that the curb is formed out of a single semi-rigid unit (Figure 3) and is provided with a split (as shown in Figure 3) for allowing the installation of the curb around the physical penetration.

Regarding claim 11: A pitch pocket according to claim 1 wherein said curb is made out of rubber (Col. 2, lines 59-60) from recycled tires. It should be noted that claim 11 is considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). Since the pitch pocket is composed of rubber the claimed limitations are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georgeau et al (543827).

Georgeau discloses the pitch pocket as in claim 12 above, but does not expressly disclose that there is a peel-off membrane that is peeled off the base before securing said curb to the roof. It is well known in the art to have an adhesive for securing having a peel-off membrane and peeling said membrane off before the step of securing. Therefore it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the curb of Georgeau to have a peel-off membrane and to peel off said membrane before securing the curb to the roof.

Allowable Subject Matter

Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JL

06/15/2006



N. Slack
Primary Examiner